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10/658,239	09/09/2003	Atsushi Shibutani	03550/LH	4112

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FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
220 Fifth Avenue
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NEW YORK, NY 10001-7708

EXAMINER

LE, TUAN H

ART UNIT	PAPER NUMBER
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2622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/658,239

Applicant(s)

SHIBUTANI, ATSUSHI

Examiner

TUAN H. LE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,8-15 and 19-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,8-15 and 19-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 2/21/08 have been fully considered but they are not persuasive.

Regarding independent **claims 1, 26, 28 and 14, 27, and 29**, which are drawn to an apparatus, method, and storage medium, the applicant submits that Kubo et al (U.S. Pat. 6, 570, 614) does not teach or suggest “storing information indicative of a relationship between a selected condition and a selected recording medium” and “recording image data meeting the selected condition in one of a plurality of recording mediums based on the information stored in the storing unit”, Remarks, page 19 lines 16-21. However, the examiner respectfully disagrees.

More specifically, Kubo teaches photographing and recording the photographed images in a selected recording medium on the photographing mode (Kubo, column 6 lines 41-48, wherein images in shutter chance mode are recorded on memory 21; the interface of memory type and photographing needs to be stored so that images can be photographed and recorded).

Therefore, Kubo teaches “storing information indicative of a relationship between a selected condition and a selected recording medium” and “recording image data meeting the selected condition in one of a plurality of recording mediums based on the information stored in the storing unit”.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 8-10, 12-15, 19-22, 24- 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Kubo et al (USPat. 6,570,614). Hereinafter Kubo et al is shortened as Kubo.

Regarding **claim 1**, Kubo discloses an image-pickup apparatus (Kubo, Fig. 1 and Fig. 2) comprising:

an input unit (switches 43 and 45) which inputs a condition-selecting instruction and a medium selecting instruction (Kubo, column 5 lines 33-42 and column 10 lines1-7, wherein a recording medium is selected for use in shutter chance mode, wherein shutter chance mode and a recording medium is selected);

an image-pickup unit (13) which takes a picture of a subject to obtain image data (Kubo, column 5 line 54, wherein CCD is used);

a condition-selecting unit (switch 43) which selects one of a plurality of conditions (macro mode, portrait mode, and sport mode) in accordance with the condition-selecting instruction(shutter chance mode), (Kubo, column 9 lines 31-54, wherein switch 43 is used in shutter chance mode);

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a medium-selecting unit (switch 45) selects, in accordance with the medium-selecting instruction, one of a plurality of recording mediums for recording image data which meets the condition selected by the condition selecting unit (Kubo, column 10 lines 1-7, wherein there are choices of memory for photographing modes), and

a storing unit (inherent part of microcomputer 16) which stores information indicative of a relationship between the condition selected by the condition-selecting unit and the recording medium selected by the medium selecting unit (Kubo, column 6 lines 41-48, wherein microcomputer 16 performs photographing in shutter chance mode and records photographed images, thus interfaces information must exist); and

a recording control unit (microcomputer 16) which records the image data meeting the condition selected by the condition-selecting unit in one of the plurality of recording mediums, based on the information stored in the storing unit, (Kubo, column 6 lines 41-48, wherein image data from ccd 13 is recorded).

Regarding **claim 5**, Kubo teaches the image-pickup apparatus of claim 1. In addition, Kubo discloses the condition selected by the condition-selecting unit is one of a plurality of photographing modes (Kubo, column 5 lines 33-42, wherein there are single-exposure mode, continuous mode, shutter chance mode).

Regarding **claim 8**, Kubo teaches the image-pickup apparatus of claim 1. In addition, Kubo discloses

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the input unit comprises a user operable section for enabling a user to input the medium-selecting instruction (Kubo, Fig. 1, wherein switch 45 is for input), and

a determining unit (inherent part of microcomputer 16 to acknowledge a medium-selecting input) which determines whether or not a user has inputted the medium-selecting instruction,

an automatic setting unit (microcomputer 16) for automatically inputting the medium-selecting instruction when the determining unit determines that the user has not inputted the medium-selecting (Kubo, Fig. 2, wherein memory card 21 is the only means to record image data for the camera).

Regarding **claim 9**, Kubo teaches the image-pickup apparatus of claim 1. In addition, Kubo discloses

the plurality of recording mediums include a detachable recording medium (Kubo, Fig. 2 and column 10 lines 1-7, wherein card driver 22 interfaces memory card 21).

Regarding **claim 10**, Kubo teaches the image-pickup apparatus of claim 9. In addition, Kubo discloses

a determining unit (inherent part of microcomputer 16) which determines whether or not the detachable recording medium has been installed when the medium-selecting unit selects the detachable recording medium, (Kubo, Fig. 2, wherein microcomputer 16 interfaces with card driver 20), and

when the determining unit (inherent part of microcomputer 16) determines that the detachable recording medium is not installed, the recording control unit (microcomputer 16) records the image data which meets the condition selected by the condition-selecting unit in a recording medium other than the detachable recording medium (memory card of another computer), (Kubo, Fig. 2 and Fig. 8, wherein IrDA 24 interfaces with another electronic camera).

Regarding **claim 12**, Kubo teaches the image-pickup apparatus of claim 1. In addition, Kubo discloses

an outputting unit (microcomputer 16 and interface 22) which sends the image data obtained by the image-pickup unit (ccd 13) to an external device (personal computer) having a recording medium which is the plurality of recording mediums, (Kubo, Fig. 2, Fig. 8, and column 6 line15-18, wherein the camera is connected to a personal computer).

Regarding **claim 13**, Kubo teaches the image-pickup apparatus of claim 1. In addition, Kubo discloses

the plurality of recording mediums comprise different types of recording media, (Kubo, column 10 lines 1-7, wherein three different types of memory are described).

Regarding **claim 14**, Kubo discloses an image recording apparatus (Kubo, Fig. 1 and Fig. 2), comprising:

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a first recording medium (card 21 for card slot 31) which stores image data (Kubo, Figs. 1-2);

an input unit (switches 44-45) which inputs a condition-selecting instruction (Play) and a medium selecting instruction from an user (Kubo, Figs. 1-2, Fig. 9, column 6 lines 15-23, wherein Replay of an exchanged image from a recording media);

a condition-selecting unit (switches 44 and 47) which selects one of a plurality of conditions (Play or Rec) in accordance with the condition-selecting instruction, (Kubo, Fig. 1, Fig. 9, wherein Play is selected);

a medium-selecting unit (switch 45) selects, in accordance with the medium-selecting instruction, one of a plurality of second recording mediums for recording image data which is stored in the first recording mediums and which meets the condition selected by the condition selecting unit (Kubo, Fig. 1, Fig. 9, wherein there medium selection is carried by 45), and

a storing unit (inherent part of microcomputer 16) which stores information indicative of a relationship between the one condition selected by the condition-selecting unit and the second recording medium selected by the medium selecting unit (Kubo, column 6 lines 41-48, wherein Play from a selected media); and

a recording control unit (microcomputer 16) which records the image data which is stored in the first recording medium and which meets the condition

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selected by the condition-selecting unit in one of the second recording mediums, based on the information stored in the storing unit, (Kubo, Fig. 1, Fig. 9, wherein reproduced image is recorded in accordance with switch 47).

Regarding **claim 15**, Kubo teaches the image-pickup apparatus of claim 14. In addition, Kubo discloses

the plurality of second recording mediums includes the first recording medium (Kubo, column 6 lines 15-25, wherein exchange of image is possible); and

the recording control unit (microcomputer 16) comprises a determining section which determines whether or not the one of the plurality of second recording mediums selected by the medium-selecting unit is the first recording medium; (Kubo, Fig. 1, wherein interface 22 checks for the mediums) and

the recording control unit (microcomputer 16) records the image data which is stored in the first recording medium and which meets the condition selected by the condition selecting unit in the selected one of the second recording mediums only when the determining unit determines that the selected one of the plurality of second recording medium is not the first recording medium (Kubo, Fig. 1, Fig. 9, wherein reproduced images can be recorded in accordance with Replay 44 and sel 47).

Regarding **claim 19**, Kubo teaches the image-pickup apparatus of claim 14. In addition, Kubo discloses

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the condition selected by the condition-selecting unit is one of a plurality of photographing modes (Kubo, wherein Replay switch 44 reflects the mode).

Regarding **claim 20**, Kubo teaches the image-pickup apparatus of claim 14. In addition, Kubo discloses

the condition selected by the condition-selecting unit is one of a plurality of predetermined photographed subjects (Kubo, Fig. 1, wherein Sel 47 indicates predetermined photographed subject).

Regarding **claim 21**, Kubo teaches the image-pickup apparatus of claim 14. In addition, Kubo discloses

the condition selected by the condition-selecting unit is one of a plurality of photographing information items included in the image data (Kubo, Fig. 1, Fig. 9 wherein Play and Sel reads information relating the image data).

Regarding **claim 22**, Kubo teaches the image-pickup apparatus of claim 14. In addition, Kubo discloses

the plurality of recording mediums include a detachable recording medium (Kubo, Fig. 1, wherein card slot 31 is available for an memory).

Regarding **claim 24**, Kubo teaches the image-pickup apparatus of claim 14. In addition, Kubo discloses

outputting unit (microcomputer 16 and interface 22) which sends the image data stored in the first recording medium to an external device(personal

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computer) having a recording medium which is one of the plural recording media (Kubo, Fig. 2, Fig. 8, and column 6 line15-18, wherein the camera is connected to a personal computer).

Regarding **claim 25**, Kubo teaches the image-pickup apparatus of claim 14. In addition, Kubo discloses

the plurality of recording mediums comprise different types of recording media, (Kubo, column 10 lines 1-7, wherein three different types of memory are described).

Regarding **claim 26**, same ground of rejection as in claim 1 is applied.

Regarding **claim 27**, same ground of rejection as in claim 14 is applied.

Regarding **claim 28**, same ground of rejection as in claim 1 is applied.

Regarding **claim 29**, same ground of rejection as in claim 14 is applied.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 and 23 is rejected under 35 U.S.C. 103(a) as obvious over Kubo et al (USPat. 6,570,614). Hereinafter Kubo et al is shortened as Kubo.

Regarding **claim 11**, Kubo teaches the image-pickup apparatus of claim 1. However, Kubo does not disclose that the recording media comprises an internal recording medium.

On the other hand, it would have been obvious to an artisan to implement an internal memory unit into the image-pickup apparatus as described by Kubo in order to store image data because such implementation eliminates the burden of carrying along an external memory unit, thus increases versatility for the image-pickup apparatus.

Regarding **claim 23**, Kubo teaches the image-pickup apparatus of claim 14. However, Kubo does not disclose that the recording media comprises an internal recording medium.

On the other hand, it would have been obvious to an artisan to implement an internal memory unit into the image-pickup apparatus as described by Kubo in order to store image data because such implementation eliminates the burden of carrying along an external memory unit, thus increases versatility for the image-pickup apparatus.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **TUAN H. LE** whose telephone number is (571)270-1130. The examiner can normally be reached on M-Th 7:30-5:00 F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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